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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,200	12/19/2000	Heung-For Cheng	42390P10465	7689
8791	7590	07/01/2005	EXAMINER	
BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD SEVENTH FLOOR LOS ANGELES, CA 90025-1030			NGUYEN, MERILYN P	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/741,200	Applicant(s) CHENG, HEUNG-FOR	
	Examiner Marilyn P Nguyen	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 17 and 19-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 17 and 19-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Detailed Action.

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DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/23/2005 has been entered.

2. In response to the communication dated 05/23/2005, claims 1-10, 17 and 19-25 are active in this application as the result of the addition of claims 20-25 and the cancellation of claims 11-16 and 18.

Acknowledges

3. Receipt is acknowledged of the following items from the Applicant:

The applicant's amendment has been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-10, 17 and 19-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding claims 1, 8, 17 and 21, these claims are being incomplete for omitting relationship between steps. See MPEP § 2172.01. For example, the step of “expanding the distribution list into its constituent recipients” is not connected to the other steps.

Regarding claim 17, there is insufficient antecedent basis for “the MTU” at line 24.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly (U.S. 6427164), in view of Gilchrist (US 5,768,505), and further in view of Japanese application No. 2000259514 published on September 22, 2000 (hereinafter JP 259514).

Regarding claims 1 and 21, Reilly disclose: A method and an apparatus for reducing network bandwidth wastage incident to sending an electronic document to a nonexistent member of a distribution list having multiple destination addresses for respective members, comprising:

a machine accessible medium having instructions encoded thereon, which when executed by the machine (col. 3, lines 61 to col. 4. lines 9, Reilly), are capable of directing the machine to perform receiving a document by a document distribution server (col. 6, lines 66 to col. 7, lines 26, Reilly);

Reilly is silent as to expanding the distribution list into its constituent recipients. On the other hand, Gilchrist teaches expanding the distribution list into its constituent recipients (See

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col. 22, lines 14-20, Gilchrist et al.). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to expand the distribution list of Reilly into its constituent recipients as suggested by Gilchrist. The motivation would have been to identify one or more destination addresses based on expanding the distribution list (See col. 14, line 62 to col. 15, line 2, Gilchrist et al.).

Reilly discloses:

recording in a database a document identifier and the distribution list (col. 7, lines 28-62, Reilly);

distributing the document to the members of the distribution list (col. 7, lines 28-62, Reilly);

receiving, in response to distributing to a first member of the distribution list, an error message comprising the document identifier (col. 7, lines 31-35, Reilly);

looking up the identifier in the database so as to identify the distribution list (col. 3, lines 3-10, and col. 9, lines 49-58, Reilly).

However, Reilly, in view of Gilchrist, does not teach automatically deleting the destination address for the first member from the distribution list so that a subsequent sending to the distribution list avoids corresponding subsequent error messages. On the other hand, JP 259514 discloses deleting the first member from the distribution list so that a subsequent sending to the distribution list avoids corresponding subsequent error messages (Please see the Abstract). Because Reilly, in view of Gilchrist, allows updating the distribution list, thus at the time invention was made, it would have been obvious to a person of ordinary skill in the art to automatically delete member from the distribution list in the system of Reilly, in view of

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Gilchrist, as taught by JP 259514. The motivation would have been to enable avoiding further error messages and network bandwidth caused by repeating the transmission of message to invalid addresses.

Regarding claim 2, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Reilly/Gilchrist/ JP 259514 disclose: wherein the wastage comprises bandwidth required for: the distributing the document to the nonexistent member (col. 7, lines 28-62, Reilly);

the error message received in response to the distributing (col. 7, lines 28-62, Reilly);
a reply by a second member of the distribution list, in response to the distributing, which is distributed to the nonexistent member; and an error message responsive to the reply (col. 8, lines 50 to col. 9, lines 10, Reilly).

Regarding claims 3 and 22, all the limitations of these claims have been noted in the rejection of claims 1 and 21, respectively. In addition, Reilly/Gilchrist/ JP 259514 discloses wherein members of the distribution list receive distributions addressed such that replies to the distributions are directed to the members of the distribution list (col. 8, lines 31-49, Reilly).

6. Claims 4-10, 17-20 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly (U.S 6427164), in view of Gilchrist (US 5,768,505), and further in view of Japanese application No. 2000259514 published on September 22, 2000 (hereinafter JP 259514), and further in view of Applicant's admitted prior art.

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Regarding claims 4-7, 20 and 23-25, all the limitations of these claims have been noted in the rejection of claims 3, 17 and 22, respectively. Reilly/Gilchrist/ JP 259514 discloses an email system, however, Reilly/Gilchrist/ JP 259514 is silent as to disclose a Messaging Application Programming Interface (MAPI) application includes an object-oriented programming language and having a Microsoft Outlook e-mail functionality in order to compose messages. Applicant's admitted prior art discloses MAPI (See page 2-3). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the MAPI application program use for composing and disposing in the system of Reilly/Gilchrist/ JP 259514 as suggested by Applicant's admitted prior art. The motivation being to make it easy for users to write message application that are independent of the underlying message system and implement message features with a small amount of code. Moreover, MAPI provides a consistent interface for multiple application programs to interact with multiple messaging systems across a variety of hardware platforms.

Regarding claims 8 and 17, most of the limitations of these claims have been noted in the rejection of claims 4-7 above. It is therefore rejected as set forth above.

Regarding claims 9 and 18, all the limitations of these claims have been noted in the rejection of claims 8 and 17, respectively. In addition, the combination of Reilly/Gilchrist/ JP 259514 and applicant's admitted prior art disclose receiving the error message (col. 7, lines 28-62, Reilly); receiving the electronic document by a distribution server which performs the

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distributing the electronic document (col. 6, lines 66 to col. 7, lines 26, Reilly), and looking up the identifier (col. 8, lines 15-30, Reilly).

Regarding claims 10 and 19, all the limitations of these claims have been noted in the rejection of claims 8 and 17, respectively. In addition, the combination of Reilly/Gilchrist/ JP 259514 and applicant's admitted prior art disclose determining the identifier based on attributes of the electronic document, the attributes comprising a subject identifier, a sending time, and a distribution list identifier (col. 7, lines 45-62, Reilly).

Response to Arguments

7. Applicant's arguments filed on 5/23/2005 about the claim rejection of the last Office Action have been fully considered but they are considered moot in view of the new grounds of rejection.

Applicant's Remarks are in response to the final Office Action mailed on February 25, 2005. Applicant argues that "Reilly's use of the forwarding address, notifying of the sending user, and then updating of the database not only does not discloses or reasonably suggest automatically deleting the destination address for the first member from the distribution list so that a subsequent sending to the distribution list avoids corresponding subsequent error messages". As addressed in the Advisory Action mailed on May 13, 2005, the Examiner respectfully disagrees, Reilly teaches automatically updating the distribution list (address book) as the old destination address (email address) of the user2 is invalid or no longer exist and the new destination address (email address) is acknowledged, wherein the invalid destination address

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is responded with an error message comprising the document identifier (user name) (See col. 7, lines 28-62 and col. 9, lines 49-58). Although Reilly discloses automatically updating the distribution list, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to automatically updating the distribution list by deleting the old email address and replacing it with the new email dresses so that avoiding subsequent error messages. The examiner used Salzfass reference to support the obviousness of Reilly. Thus, the use of Reilly, in view of Salzfass is relevant. However, as of the new grounds of rejection, the Examiner uses better reference (JP 2000259514), as Examiner's belief, to support the obviousness of "automatically deleting the destination address for the first member from the distribution list so that a subsequent sending to the distribution list avoids corresponding subsequent error messages" of Reilly.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marilyn P. Nguyen whose telephone number is 571-272-4026. The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MN
June 21, 2005


FRANTZ COBY
PRIMARY EXAMINER